

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte PATRICE DIONNE

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Appeal No. 2002-1198  
Application 09/349,306

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ON BRIEF

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Before FRANKFORT, STAAB, and BAHR, Administrative Patent Judges.  
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 4, which are all of the claims remaining in this application.

As set forth on page 1 of the specification, appellant's invention relates to the game of golf and, more particularly, to a method of chipping around the green. That method involves selecting a golf club having an elongate shaft, having a club head that is disposed at a substantially one hundred degree angle

relative to the elongate shaft, and having a lofted club face; maintaining the golf club in a substantially vertical plane by first and second hands of a golfer standing in an erect posture and facing a target hole; with a golf ball positioned near a preselected foot of the golfer on an exterior side thereof; and executing a chip shot by swinging the club head with a motion and with a force substantially equal to a motion and force used to perform an underhand toss of a golf ball toward the target golf hole. In the paragraph bridging pages 4 and 5 of the specification, appellant defines what is meant by a golfer "standing erect" or being in an erect posture, i.e., that "said golfer does not bend over at the waist, nor does said golfer bend his or her knees;" in addition, "the golfer's head is not bent downwardly to look at the ball and . . . the golfer does not lean to either side." Independent claim 1 is representative of the subject matter on appeal and a copy of that claim may be found in the Appendix to appellant's brief.

The prior art references relied upon by the examiner in rejecting the appealed claims are:

White	5,830,082	Nov. 3, 1998
Shiraishi	5,890,971	Apr. 6, 1999
Williams	5,976,025	Nov. 2, 1999
Gidney	6,039,657	Mar. 21, 2000
		(filed Jan. 15, 1998)

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Williams in view of White and Gidney.

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Williams in view of White and Gidney as applied to claim 1 above, and further in view of Shiraishi.<sup>1</sup>

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the final rejection (Paper No. 11, mailed June 20, 2001) and examiner's answer (Paper No. 14, mailed October 10, 2001) for the reasoning in support of the rejections, and to appellant's brief (Paper No. 13, filed July 30, 2001) for the arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

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<sup>1</sup>As noted on page 3 of the examiner's answer, the rejection based on the Hedges patent (US 6,068,562) made in Paper No. 9 has been withdrawn by the examiner.

Looking first at the examiner's rejection of claim 1 under 35 U.S.C. § 103(a) based on the combined teachings of Williams, White and Gidney, we note that Williams discloses a golf putter having an elongate shaft (16) and a putter head (4) that is equipped with three ball-striking surfaces (13, 34 and 36). As noted in column 1, lines 37-57, the Williams putter can be used by either right-handed or left-handed golfers, employing either a stance facing the target or a stance facing perpendicular to the ball roll path, thereby allowing a golfer to experiment with different stances and, with the benefit of such experimentation, permitting the golfer to adopt the stance and stroke that is most comfortable and productive. Figures 7, 8, 10 and 11 show golfers using the putter of Williams in a non-conventional stance facing the target golf hole, while Figures 13 and 14 show golfers using the putter in conventional stances facing perpendicular to the ball roll path.

The examiner's position that Williams "clearly teaches that the golfer can choose an appropriate posture, including a fully erect stance" (answer, pages 7-8), and that Williams (Figs. 8 and 10) "disclose that the golfer stands in 'erect' posture" (final rejection, page 5), is unsupported by the teachings of that reference. Nothing in the Williams patent teaches or suggests a

"fully erect posture" as required in appellant's claims 1 and 4 on appeal. Contrary to the examiner's assertions, Figures 8 and 10 of Williams do not show the golfer in an "erect" posture.

Webster's New World Dictionary, Second College Edition, Prentice Hall Press, 1986, defines "erect" as meaning "1. Not bending or leaning; straight up; upright; vertical." This definition is consistent with that provided by appellant in the paragraph bridging pages 4 and 5 of the specification of the present application, wherein appellant notes that the golfer of Figure 1 is "standing erect," i.e., the golfer does not bend over at the waist, does not bend his or her knees, and, in addition, that the golfer's head is not bent downwardly to look at the ball and the golfer does not lean to either side. Thus, with this understanding, it is clear that Williams does not teach, suggest or show a golfer in a "fully erect posture." Moreover, as conceded by the examiner (final rejection, page 3), Williams fails to teach or suggest anything regarding a "chip shot," which golf shot is the central focus of appellant's method claims on appeal.

Independent claim 1 on appeal further requires the step of

performing said steps [i.e., those set forth in the claim for making a chip shot] with a golf club head disposed at a substantially one hundred degree angle relative to said

elongate shaft so that a sole of said club head is substantially parallel to the ground at the moment of impact of the club head against the ball and so that said shaft is positioned at an angle of about ten degrees relative to an imaginary line that is perpendicular to a putting surface.

The examiner's determination (final rejection, page 3; answer, page 4) that Williams discloses a golf club having the required structure and performing the required steps, is without merit. The golf putter of Williams is not configured as required in appellant's claim 1 on appeal when the toe ball-striking surface (13) therein is used by the golfer standing in a position facing the target golf hole as seen in either Figures 7 and 8, or Figures 10 and 11 of Williams. As is apparent from Figures 9 and 12, the shaft (16) of the club in Williams is not oriented "so that said shaft is positioned at an angle of about ten degrees relative to an imaginary line that is perpendicular to a putting surface," as set forth in claim 1 on appeal. Figures 8 and 9, or Figures 11 and 12 of Williams clearly show the shaft (16) of the club positioned at 90° to the putting surface, i.e., aligned with an imaginary line that is perpendicular to the putting surface.

Regarding White, we observe that this patent discloses a golf chipper club having an elongate shaft (18) with two gripping portions (16, 17) and a lofted head having a loft angle of between about 25 degrees and 45 degrees. As is readily apparent

from viewing Figures 1 and 2 of White, this patent teaches that the golfer is in a conventional stance facing perpendicular to the ball roll path when executing a chip shot and in a posture with head and shoulders bent downwardly toward the ball, not "standing in a fully erect posture and facing a target golf hole," as required in claim 1 on appeal.

As for Gidney, this patent addresses a golf putter (Fig. 5b) that may have an elongate shaft (570) and two gripping areas (550, 560), wherein the club is used by a golfer standing in an erect posture during putting and in a stance facing the target golf hole. The ball striking face (118) of the club head may be provided with a loft of between 0 and 10 degrees (col. 4, lines 56-57). However, as urged by appellant (brief, pages 5-6), it does not appear that the club of Gidney (Fig. 5b) is configured as required in claim 1 on appeal, i.e., "with a golf club head disposed at a substantially one hundred degree angle relative to said elongate shaft . . . so that said shaft is positioned at an angle of about ten degrees relative to an imaginary line that is perpendicular to a putting surface."

The examiner has asserted that it would have been obvious to one having ordinary skill in the art at the time the invention was made "to have utilized the teachings as taught by White and

Gidney in the Williams method of making a shot to improve a golfer's performance and the training of a golfer for making a chip shot" (final rejection, page 4). Like appellant, we see no basis in the applied references for any such modification of "the Williams method" and consider that the examiner has engaged in a hindsight reconstruction of appellant's claimed method by impermissibly utilizing appellant's own disclosure and claims as a target to be hit by invention-guided manipulation of the disparate references (brief, pages 5 and 7). In that regard, we note, as our court of review indicated in In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992), that it is impermissible to use the claimed invention as an instruction manual or "template" in attempting to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious.

In light of the foregoing, it is our determination that the examiner's rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Williams in view of White and Gidney will not be sustained.

Turning now to the examiner's rejection of claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Williams, White, Gidney and Shiraishi, we have reviewed the Shiraishi patent but



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find nothing therein which would provide for, or otherwise render obvious, that which we have found above to be lacking in the examiner's asserted combination of Williams, White and Gidney. Thus, the examiner's rejection of dependent claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Williams, White, Gidney and Shiraishi will also not be sustained.

It follows from the foregoing that the decision of the examiner rejecting claims 1 and 4 of the present application under 35 U.S.C. § 103(a) is reversed.

REVERSED

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JENNIFER D. BAHR	)	
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